

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Or, *et al.*
Serial No.: 10/007235
Docket No.: ENP-036
Filing Date: 10/22/01

Examiner: R. Anderson

TITLE: Alpha-Hydroxyarylbutanamine Inhibitors of Aspartyl Protease

BY FACSIMILE TRANSMISSION: 703-746-7444

Commissioner of Patents and Trademarks
Washington, D.C. 20231

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON
FAILURE TO RECEIVE OFFICE ACTION**

Dear Sir:

On August 21, 2002, Ms. Rebecca Anderson, the examiner in the above-identified application called the office of the applicants' assignee, Enanta Pharmaceuticals, Inc. and stated that the application had been held to be abandoned for failure to respond to an Office Action which had been mailed by the United States Patent and Trademark Office (USPTO) on February 7, 2002. Ms. Anderson stated that the Office Action included a restriction requirement and a requirement for election of species and specified a time period of one month for response.

The Office Action has not been received at the offices of the applicants' assignee, Enanta Pharmaceuticals, Inc. 500 Arsenal Street, Watertown, MA 02472, which is designated in the Utility Patent Application Transmittal form as the correspondence address for the application.

Applicants' undersigned attorney has made a search of the file jacket of the application, and of the patent docket records, maintained by the applicants' assignee.

The file jacket and the docket records show conclusively that the Office Action was not received.

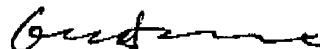
Attached hereto as Exhibit 1 is a copy of the first, fifth and sixth pages of a document maintained by applicants' assignee, entitled "Actions Due and Mail Received from PTO". This docket, which identifies the listed applications by Attorney Docket

Number, ENP-036 in the case of the present application, lists all the documents received, starting as of January 25, 2002, in the patent applications of applicants' assignee. Page 6 of this record shows that a return postcard for an Information Disclosure Statement filed in the present application was received February 1, 2002 and a Recordation of Assignment was received on February 25, 2002. It can be seen that the Office Action in question was not received as of March 7, 2002 which would have been the end of the one month response period specified in the Office Action.

Applicants' assignee also maintains a docket record entitled "Patent Docket" which docketed all actions due in the patent applications of the applicants' assignee. Attached hereto, as Exhibits 2 and 3, respectively, is a copy of each of the Patent Docket documents dated February 26, 2002 and March 13, 2002 which show all replies docketed for a date one month from the mailing date of the nonreceived Office Action. It can be seen that there is no entry in the Action Due column for the present application (see page 4 of each of these exhibits).

It is respectfully submitted that the showing made by this Petition clearly establishes nonreceipt of the Office Action mailed February 7, 2002. It is therefore respectfully requested that this Petition be granted and, further, that the Office Action be remailed.

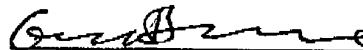
Respectfully Submitted,



Gaetano D. Maccarone
Reg. No. 25,173

Certificate of Facsimile Transmission

I hereby certify that this correspondence is being submitted to the United States Patent and Trademark Office via facsimile transmission today to 703-746-7444.



Date: August 22, 2002

EXHIBIT 1**Actions Due and Mail Received from PTO**

Doc. #	Item	Date	Starting 1/25/02 Comments
ENP-038	Postcard returned	8/21/02	From IDS Filing.
ENP-036	Call from Examiner	8/21/02	Call about a Restriction sent in Feb., we never received, therefore no reply. Case has been abandoned. Need to send in letter requesting withdrawal of abandonment.
ENP-009 PCT	Notification of Communication	8/19/02	From IB
ENP-026	Office Action	8/19/02	Rejection of Claims
ENP-037-P-1	Assignment Doc to fill out	8/16/02	From Lahive - need inventors signatures to be notarized
ENP-018 PCT	Postcard received	8/15/02	From resent reply and petition to correct filing date etc.
ENP-016 PCT	Letter from Lahive	8/13/02	Request to advise which countries to enter National Stage in by August 23, 2002
Harvard Ref. No. 1472-98	File copy from Fish & Richardson	8/9/02	File copy of Notice to comply and response
ENP-021	Office Action	8/9/02	Claims 1-10 pending
ENP-018	ISSUE NOTIFICATION	8/8/02	Application No. 09/824,318 ENP-018 will issue as Patent No. 6436906 on 8/20/02 - Confirmation No. 9402
ENP-018 PCT	Notification Re: Priority Doc	8/6/02	Notification that priority doc was received July 9, in compliance of rule 17.1
ENP-034	Recordation Doc	8/5/02	
ENP-040	Postcard received	8/5/02	10/205018
ENP-039	Postcard received	8/5/02	10/205357
ENP-021 PCT	Postcard received	8/5/02	PCT/US 02/23878
ENP-017 PCT	Notification of Withdrawal of International Application or Designations	8/2/02	
ENP-038	Recordation Doc	8/2/02	
ENP-028	IDS Postcard Received	7/29/02	
ENP-029	IDS Postcard Received	7/29/02	

EXHIBIT 1

ENP-019 PCT	Postcard received	4/1/02	Return Postcard from filing received, noted and filed
ENP-009	Postcard received	4/1/02	Return postcard received from Response to Office Action sent to USPTO by Guy.
Harvard Ref. No. 1472-98 (US) F&R # 00246-258001	Letter from F&R received explaining a request for sequence listing	4/1/02	Letter from F&R received explaining sequence listing was requested by USPTO (Copies of USPTO request included). Also states F&R will attend to the filing of the sequence listing.
ENP-017 PCT	Notice from USPTO	3/26/02	Notification Concerning Payment; Notification of the Intl. App. No. & Filing Date; Invitation to Correct Defects; Notification Regarding Certain Corrections Made Ex Officio
ENP-026	Corrected filing receipt	3/19/02	
ENP-019	Postcard received	3/11/02	Postcard from Assignment & Recordation sent in 1/29/02
ENP-019	Letter received	3/11/02	Notice regarding Power of Attorney - Power of Atty application is accepted
Harvard Ref No. 1472-98 Hungary	Letter from Fish & Richardson received	3/11/02	Along with our file copy of the communication from the Hungarian patent office assigning a Hungarian App. No. to the case
ENP-009	Office Action received	3/7/02	Given immediately to Ron - response will be mailed asap
ENP-019 PCT	Filed	3/5/02	
ENP-017 PCT	Postcard received	3/4/02	PCT postcard received-PCT No. put on xls sheet -filed
ENP-018 PCT	Postcard received	2/26/02	PCT postcard received-PCT No. put on xls sheet -filed
ENP-009 PCT	Postcard received	2/26/02	PCT postcard received-PCT No. put on xls sheet -filed
ENP-016 PCT (ENJ-001PC) Lahive	Copy of Form PCT/IB/332 from International Bureau to Lahive	2/25/02	Copy of Form PCT/IB/332 (Information Concerning Elected Offices Notified of Their Election) sent to us from Lahive - shown to Ron - filed
ENP-032	Postcard from IDS	2/25/02	Received Stapled into folder, noted on xls. Spreadsheet
ENP-026	Recordation of Assignment	2/25/02	Received; Patent Serial # recorded on XLS spreadsheet, filed; Reel and Frame on file
ENP-033	Recordation of Assignment	2/25/02	Received, filed; Reel and Frame on file
ENP-035	Recordation of Assignment	2/25/02	Received; filed; Reel and Frame on file

EXHIBIT 1

ENP-032	Recordation of Assignment	2/25/02	Received; filed; Reel and Frame on file
ENP-036	Recordation of Assignment	2/25/02	Received; filed; Reel and Frame on file
Harvard Ref No. 1472-98 Application No. 09/949,280	IDS filed by Fish & Richardson 2/8/02. Copy of IDS received	2/25/02	Shown to Ron - and filed
ENP-030 & ENP-031	Missing Parts	2/14/02	Put on hold by Sandhya- may not have to do - did we receive confirmation?
ENP-027	Recordation of Assignment	2/11/02	Received, filed; Reel and Frame on file
Harvard Ref No. 1472-98 Hungary	Correspondence from Fish and Richardson	2/4/02	Noting Hungarian App. No. P0103260. Showed to Ron - noted on XLS sheet - filed in my files
ENP-026	Postcard from IDS	2/1/02	Received Stapled into folder, noted on xls. Spreadsheet
ENP-035	Postcard from IDS	2/1/02	Received Stapled into folder, noted on xls. Spreadsheet
ENP-036	Postcard from IDS	2/1/02	Received Stapled into folder, noted on xls. Spreadsheet
ENP-030	Postcard from IDS	1/25/02	Received. Stapled into folder, noted on xls. Spreadsheet

EXHIBIT 2

Patent Docket

Enanta Docket #	Title	Inventor	Filing Date	Serial #	Responsible Attny/File #	Action Due	Action Due Date	Comments	Publication Date
ENP-019 PCT	Cyclosporins for the Treatment of Respiratory Diseases	Or, Lazarova			S. Kalkunte	Foreign File	3/5/2002	Filing Papers Partially prepared	Sep-02
ENP-021 PCT	4'-Substituted Leucomycins	Or, Phan, Z. Wang, Jian			S. Kalkunte	Foreign File	7/27/2002		Jan-03
ENP-028	23-O-Substituted 5-O-Mycaminosyltolonide Derivatives	Phan et al.			S. Kalkunte	File	2/7/02	Filing Papers Partially Prepared - Assignments Notarized	
ENP-029	5-O-Mycaminosyltolonide Derivatives	Phan et al.			S. Kalkunte	File	2/7/02	Filing Papers Partially Prepared - Assignments Notarized	
ENP-007-PCT	Bifunctional Inhibitors of Malarial Proteases and uses thereof	Eckstein	4/12/2001	PCT/US01/12000	Choate, Hall & Stewart 2002950-0003			Demand Filed 9/7/01	Published on 11/8/2001
ENP-009	14-Membered Macrolides Derived from Leucomycins	Or, Lazarova, Binet, J. Wang	12/22/2000	09/747,578	S. Kalkunte/ G. Maccarone				6/2/2002

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EXHIBIT 2

Patent Docket

Enanta Docket #	Title	Inventor	Filing Date	Serial #	Responsible Attorney/File #	Action Due	Action Due Date	Comments	Publication Date
ENP-009 PCT	14-Membered Macrolides Derived from Leucomycins	Or, Lazarova, Binet, J. Wang	12/21/2001	PCT/US01/51041	S. Kalkunte				Jun-02
ENP-016 PCT	Methods for Identifying Peptide Aptamers Capable of Altering a Cell Phenotype	Benson	4/4/2001	PCT/US01/10953	Lahive & Cockfield ENJ-001-PC			Demand filed 10/31/2001	Published on 10/11/2001
ENP-017	Bicyclic Leucomycins	Or, Binet, Phan	2/16/2001	09/785,727	S. Kalkunte/ G.Maccarone				8/2/2002
ENP-017 PCT	Bicyclic Leucomycins	Or, Binet, Phan	1/17/2002		S. Kalkunte				Aug-02
ENP-018	9-Amino-14-Membered Macrolide Derived from Leucomycin	Or, Vo, J. Wang, Phan	4/2/2001	09/824,318	S. Kalkunte/ G.Maccarone				10/2/2002
ENP-018 PCT	9-Amino-14-Membered Macrolide Derived from Leucomycin	Or, Vo, J. Wang, Phan	12/21/2001	PCT/US01/51040	S. Kalkunte				Jun-02

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EXHIBIT 2

Patent Docket

Enanta Docket #	Title	Inventor	Filing Date	Serial #	Responsible Attny/File #	Action Due	Action Due Date	Comments	Publication Date
ENP-019	Cyclosporins for the Treatment of Respiratory Diseases	Or, Lazarova	3/5/2001	09/800,856	S. Kalkunte/ G. Maccarone			Originally given # ENP-011.	9/22/2002
ENP-021	4'-Substituted Leucomycins	Or, Phan, Z. Wang, Jian	7/27/2001	09/917,107	S. Kalkunte/ G. Maccarone			IDS Filed 10/24/01	Jan-03
ENP-026	4'-O-Substituted Tylosin Analogs	Phan et al.	11/8/2001	10/007,744	S. Kalkunte			IDS Filed 12/18/01 - Postcard return received 2/1/02	5/3/2003
ENP-027	Novel Tylosin Derivatives Having Antibacterial Activity	Phan et al.	11/15/2001	10/002,918	S. Kalkunte			IDS Filed 12/18/01	5/3/2003
ENP-030	Cyclosporin Analogs for the Treatment of Autoimmune Diseases	Or et al.	10/12/2001	09/976,219	S. Kalkunte			IDS Filed 12/18/01 - Postcard return received 1/25/02	4/3/2003
ENP-031	Cyclosporin Analogs for the Treatment of Lung Diseases	Or et al.	10/12/2001	09/975,923	S. Kalkunte			IDS Filed 12/18/01	4/3/2003

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EXHIBIT 2**Patent Docket**

Enanta Docket #	Title	Inventor	Filing Date	Serial #	Responsible Attny/File #	Action Due	Action Due Date	Comments	Publication Date
ENP-032	11-O-Substituted Macrolides and their Descladinose Derivatives	Phan et al.	12/3/2001	10/011,322	S. Kalkunte			IDS filed 1/16/02 - Postcard return received 2/25/02	6/3/2003
ENP-033	Novel 11-O-Substituted Ketolide Derivatives	Phan et al.	12/4/2001	10/011,642	S. Kalkunte			IDS Filed 12/18/01	6/4/2003
ENP-035	Nitrogen Heterocycle Inhibitors of Aspartyl Protease	Guoqiang et al.	10/22/2001	10/007,342	S. Kalkunte			IDS Filed 12/18/01 - Postcard Received 2/1/02	4/3/2003
ENP-036	Alpha- Hydroxyarylbuanamine Inhibitors of Aspartyl Protease	Or et al.	10/22/2001	10/007,235	S. Kalkunte			IDS Filed 12/18/01 Postcard Received 2/1/02	4/3/2003
ENP-037P	Methods for Identifying Peptide Aptamers Capable of Altering a Cell Phenotype	Beason	11/6/2001		Lahive & Cockfield ENI-004-1			Need copy of filing papers as requested from Lahive - Provisional Application	
Harvard Ref. No. 1472-98 (US)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	09/273,597	F&R 00246-258001			Advisory Action received on 10/12/01; Request for Continued Examination filed on 10/29/01	

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EXHIBIT 2**Patent Docket**

Enanta Docket #	Title	Inventor	Filing Date	Serial #	Responsible Attorney/File #	Action Due	Action Due Date	Comments	Publication Date
Harvard Ref. No. 1472-98 (US-DIV)	Divisional application "Synthesis of Compounds and Libraries of Compounds"	Verdine et al.	9/7/2001	09/949,280	F&R 00246-258002			IDS Filed by F&R 2/8/02	3/3/2003
Harvard Ref. No. 1472-98 (Canada)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	2324016	F&R 00246-258CA1			First maintenance fee paid 2/28/01	
Harvard Ref. No. 1472-98 (EPO)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	999912805.1	F&R 00246-258EP1				
Harvard Ref. No. 1472-98 (Hungary)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	PCT/US99/06233 Hungary App. No. P0103260	F&R 00246-258HU1				
Harvard Ref. No. 1472-98 (Israel)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	138647	F&R 00246-258IL1				
Harvard Ref. No. 1472-98 (PCT)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	PCT/US99/06233	Foley, Hoag & Elliott/HUV-033.25			Entered National Phase 9/22/00 (9/25/00 in Japan)	9/30/1999

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EXHIBIT 3

Patent Docket

Enanta Docket #	Title	Inventor	Filing Date	Serial #	Responsible Attny/File #	Action Due	Action Due Date	Comments	(Expected) Publication Date
ENP-021	4'-Substituted Leucomycin	Or, Phan, Z. Wang, Jian	7/27/2001	09/917,107	S. Kalkunte/ G. Maccarone	Foreign File	7/27/2002	IDS Filed 10/24/01	(Jan-03)
ENP-007-PCT	Bi-functional Inhibitors of Malarial Proteases and uses thereof	Eckstein	4/12/2001	PCT/US01/12000	Choate, Hall & Stewart 2002950-0003			Demand Filed 9/7/01	11/8/2001
ENP-009	14-Membered Macrolides Derived from Leucomycin	Or, Lazarova, Binet, J. Wang	12/22/2000	09/747,578	S. Kalkunte/ G. Maccarone				
ENP-009 PCT	14-Membered Macrolides Derived from Leucomycin	Or, Lazarova, Binet, J. Wang	12/21/2001	PCT/US01/51041	S. Kalkunte				(Jun-02)
ENP-016 PCT	Methods for Identifying Peptide Aptamers Capable of Altering a Cell Phenotype	Benson	4/4/2001	PCT/US01/10953	Lahive & Cockfield ENJ -001-PC			Demand filed 10/31/2001	10/11/2001
ENP-017	Bicyclic Leucomycin	Or, Binet, Phan	2/16/2001	09/785,727	S. Kalkunte/ G. Maccarone				

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EXHIBIT 3**Patent Docket**

Enanta Docket #	Title	Inventor	Filing Date	Serial #	Responsible Attny/File #	Action Due	Action Due Date	Comments	(Expected) Publication Date
ENP-017 PCT	Bicyclic Leucomycins	Or, Binet, Phan	1/17/2002	PCT/US02/01427	S. Kalkunte			PCT postcard received 3/4/02	(Aug-02)
ENP-018	9-Amino-14-Membered Macrolide Derived from Leucomycin	Or, Vo, J. Wang, Phan	4/2/2001	09/824,318	S. Kalkunte/ G.Maccarone				
ENP-018 PCT	9-Amino-14-Membered Macrolide Derived from Leucomycin	Or, Vo, J. Wang, Phan	12/21/2001	PCT/US01/51040	S. Kalkunte				(Jun-02)
ENP-019	Cyclosporins for the Treatment of Respiratory Diseases	Or, Lazarova	3/5/2001	09/800,856	S. Kalkunte/ G.Maccarone			Originally given # ENP-011.	
ENP-019 PCT	Cyclosporins for the Treatment of Respiratory Diseases	Or, Lazarova	3/5/2002		S. Kalkunte				(Sept-02)
ENP-026	4'-O-Substituted Tylosin Analogs	Phan et al.	11/8/2001	10/007744	S. Kalkunte			IDS Filed 12/18/01 - Postcard return received 2/1/02	(May-03)

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EXHIBIT 3

Patent Docket

Enanta Docket #	Title	Inventor	Filing Date	Serial #	Responsible Attorney/Attorney #	Action Due	Action Due Date	Comments	(Expected) Publication Date
ENP-027	Novel Tylosin Derivatives Having Antibacterial Activity	Phan et al.	11/15/2001	10/002,918	S. Kalkunte			IDS Filed 12/18/01	(May-03)
ENP-030	Cyclosporin Analogs for the Treatment of Autoimmune Diseases	Or et al.	10/12/2001	09/976,219	S. Kalkunte			IDS Filed 12/18/01 - Postcard return received 1/25/02	(Apr-03)
ENP-031	Cyclosporin Analogs for the Treatment of Lung Diseases	Or et al.	10/12/2001	09/975,923	S. Kalkunte			IDS Filed 12/18/01	(Apr-03)
ENP-032	11-O-Substituted Macrolides and their Descladinose Derivatives	Phan et al.	12/3/2001	10/011,322	S. Kalkunte			IDS filed 1/16/02 - Postcard return received 2/25/02	(Jun-03)
ENP-033	Novel 11-O-Substituted Ketolide Derivatives	Phan et al.	12/4/2001	10/011,642	S. Kalkunte			IDS Filed 12/18/01	(Jun-03)
ENP-035	Nitrogen Heterocycle Inhibitors of Aspartyl Protease	Guoqiang et al.	10/22/2001	10/007,342	S. Kalkunte			IDS Filed 12/18/01 - Postcard Received 2/1/02	(Apr-03)

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EXHIBIT 3

Patent Docket

Enanta Docket #	Title	Inventor	Filing Date	Serial #	Responsible Attny/File #	Action Due	Action Due Date	Comments	(Expected) Publication Date
ENP-036	Alpha-Hydroxyacylbutanamine Inhibitors of Aspartyl Protease	Or et al.	10/22/2001	10/007,235	S. Kalkunte			IDS Filed 12/18/01 Postcard Received 2/1/02	(Apr-03)
ENP-037P	Methods for Identifying Peptide Aptamers Capable of Altering a Cell Phenotype	Beusson	11/6/2001		Lahive & Cockfield BNJ-004-1			Need copy of filing papers as requested from Lahive - Provisional Application	(May-03)
Harvard Ref. No. 1472-98 (US)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	09/273,597	F&R 00246-258001			Advisory Action received on 10/12/01; Request for Continued Examination filed on 10/29/01	
Harvard Ref. No. 1472-98 (US-DIV)	Divisional application "Synthesis of Compounds and Libraries of Compounds"	Verdine et al.	9/7/2001	09/949,280	F&R 00246-258002			IDS Filed by F&R 2/8/02	
Harvard Ref. No. 1472-98 (Canada)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	2324016	F&R 00246-258CA1			First maintenance fee paid 2/28/01	
Harvard Ref. No. 1472-98 (EPO)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	999912805.1	F&R 00246-258EP1				

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Patent Docket**EXHIBIT 3**

Enanta Docket #	Title	Inventor	Filing Date	Serial #	Responsible Attny/File #	Action Due	Action Due Date	Comments	(Expected) Publication Date
Harvard Ref. No. 1472-98 (Hungary)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	P0103260	F&R 00246-258HUI				
Harvard Ref. No. 1472-98 (Israel)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	138647	F&R 00246-258ILL				
Harvard Ref. No. 1472-98 (PCT)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	PCT/US99/06233	Foley, Hoag & Elliot/HUV-033.25			Entered National Phase 9/22/00 (9/25/00 in Japan)	9/30/1999
Harvard Ref. No. 1472-98 (Japan)	Synthesis of Compounds and Libraries of Compounds	Verdine et al.	3/22/1999	2000-537880	F&R 00246-258JPI				

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